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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,110	02/11/2004	Shigeru Tago	HIRA.0143	3621
7590		07/30/2007		
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			EXAMINER	
			SKIBINSKY, ANNA	
			ART UNIT	PAPER NUMBER
			1631	
			MAIL DATE	DELIVERY MODE
			07/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/775,110	TAGO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anna Skibinsky	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **REQUEST FOR CONTINUED EXAMINATION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/2007 has been entered.

### ***Reply to Applicant's Amendments***

Applicant's amendments to claims 1, and 4 are acknowledged. Claims 2 and 5 are cancelled.

### ***Objection to the Specification***

The amendments to the specification filed 3/06/2006 were sufficient to overcome this rejection. This rejection is hereby withdrawn.

### ***Objection to Claims***

The amendments filed 2/28/2007 are sufficient to overcome the objection to claims 6 and 8. The objection is hereby withdrawn.

Claims 7 and 8 are objected to as being dependent from cancelled claims 2 and 5. Claims 7 and 8 are withdrawn and no longer treated on the merits.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

*NEW MATTER*

2. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

3. Applicants have amended claim 1, drawn to a method and claim 4, drawn to a program embedded in a storage medium to recite "said method consisting of" and "said program consisting of". Applicants do not have support in the specification for the method and program to be defined solely by the scope of the claim with respect to what unrecited additional steps or components are excluded from the scope of the claim. For example, the specification recites that in step 801, the user enters a character string representing a base or amino acid sequence and a space is inserted between the character strings representing the individual sequences (page 7, lines 12-20).

Additionally, Figure 8 depicts a flow chart of the invention and includes steps such as entering 801, processing 802 the sequences, checking if all of the text data files are processed 808, not included in claims 1 and 4. Furthermore, the instant claims do not include steps of checking if all the text data files have been processed 808 and

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returning to step 803 (page 8, lines 10-17), checking if identifiers correspond 809 and if not returning to step 806 (page 8, lines 18-23), checking if all of the keywords have been processed 811, and increasing appearance frequency by one 813, of Figure 8. Therefore, the method (and components) of the invention comprise additional steps (and components) to those recited in claims 1 and 4, thus the amendment reciting "consisting" is deemed new matter.

4. Applicants had amended the instant claims (filed 9/05/2006) to recite "a first document" and "second document" in regards to the extraction steps from the first and second database. Upon additional consideration, this is deemed as new matter because the specification only provides support for "a first text data" and "a second text data" extraction. The extraction of a "document" embodies a broader scope because a document can be one that is either a text document, graph document, photo or picture document and so on. A document is not necessarily textual and the specification does not provide support for the extraction of data that is other than text data.

5. Applicants have amended claims 1 and 4 to recite that the keyword table contains "predefined keywords". The specification lacks support of the instant limitation and does not suggest or define the keywords as somehow being predefined. Support was not found and none was pointed to by Applicants.

6. Applicants have amended claims 1 and 4 to recite "counting per document a number of extracted second documents containing said keywords therein". The specification lacks support of the instant limitation and does not suggest or define that

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the number of extracted second documents are somehow counted within each document. Support was not found and none was pointed to by Applicants.

***Claim Rejections - 35 USC § 112-2<sup>nd</sup> paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1 and 3 recite a method, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a "step" but does not actually recite an active step in an active voice.

10. Claim 1, line 15, and claim 4 recites "from said first database". It is unclear what is from said first database, "a keyword table" in line 14 or "genes or proteins".

Clarification is required.

11. Claim 1, line 17, and claim 4 recites "counting per document a number of extracted second documents" which is unclear as to what is meant by a plurality of extracted second documentss can be counted per document. This limitation is vague and indefinite and clarification is required.

12. Claim 1, lines 16-18, and claim 4 recites "calculating a frequency of appearance of each of said keywords by automatically and mechanically counting per document a

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number of extracted second documents containing said keywords therein". It is unclear as to what is meant by calculating a frequency of keywords by counting per document an number of extracted second documents. Clarification is required.

13. Claim 1, lines 19-20, and claim 4 recites "keywords in a corresponding position in said keyword table". This is vague and indefinite as to the positions of the keywords correspond to. Clarification is required.

14. Claim 1, lines 21-20, and claim 4 recite "to determine whether to select or change a research course," which is vague and indefinite because it is unclear if this is an intended use of an active step of determining.

15. Claim 1, lines 23-24, and claim 4 recites "wherein said keyword table has a tree structure in which keywords are stored such that they are classified according to categories". This is vague and indefinite because it is unclear as to what limitation of the method this pertains to. This is not a method step but describes the keyword table and is therefor nonfunctional descriptive material, not given patentable weight.

16. Claim 1 and claim 4 recites a "method consisting" which renders the method closed to further steps however, claim 3 recites further steps in the method.

17. Claim 4 recites a "program consisting" which renders the program closed to other program components however, claim 6 improperly recites yet another program.

18. Claim 3 recites "said first text data extraction". There is insufficient antecedent basis for this limitation as no "text data extraction" is recited in claim 1 from which claim 3 depends.

***Claim Rejections - 35 USC § 103***

The rejection of claim(s) 1, 3, 4 and 6-8 over Murray et al in view of Getchius in the Office Action filed 11/29/2006 is withdrawn in view of Applicant's Remarks/Amendments filed 4/26/2007. It is noted that the prior art rejection of record has been withdrawn in view of Applicant's amendments reciting that the method and program are "consisting of" the claimed steps and components. However, the new matter rejection above has been introduced because the specification does not provide support for "consisting" and discloses additional steps and components not recited in the claims.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, 4 and 6-8 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Skibinsky whose telephone number is (571) 272-4373. The examiner can normally be reached on 8 am - 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anna Skibinsky, PhD



**RAM R. SHUKLA, PH.D.**  
**SUPERVISORY PATENT EXAMINER**